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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,850	02/14/2001	Steven Mark Gebert	BLD920000048US1	9299

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EXAMINER

CAMPBELL, JOSHUA D

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/782,850

Applicant(s)

GEBERT ET AL.

Examiner

Joshua D Campbell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 01/29/2002.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is responsive to communications: Application filed on 02/14/2001, and IDS filed on 01/29/2002.
2. Claims 1-42 are pending in this case. Claims 1, 15, and 29 are independent claims.

### ***Drawings***

3. The drawings were received on 02/14/2001. These drawings are accepted.

### ***Claim Objections***

4. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 25-43 have been renumbered 24-42.

5. Claims 13, 27, and 41 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The

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limitation that the page objects include only content and format for one page is already stated in the independent claims that these claims depend upon.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-3, 5, 7-8, 10-17, 19, 21-22, 24-31, 33, 35-36, 38-42 rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. (hereinafter Rivette, US Patent Number 6,018,749, issued on January 25, 2000) in view of Barry et al. (hereinafter Barry, US Patent Number 6,606,165, filed on January 8, 1999).

**Regarding independent claim 1 and dependent claim 13,** Rivette discloses a method in which a source document and a layout document (image document), which specifies layout and format of the content, are received (column 3, line 30-column 5, line 12 of Rivette). These documents are then processed to determine formatting properties including page divisions for content (column 3, line 30-column 5, line 12 of Rivette). Rivette does not disclose that multiple page objects are generated that include source content and formatting properties for one page or that the page objects are rasterized to be rendered for output. However, Barry discloses a method in which a document is split into multiple page objects that contain the source content and formatting for one page and that the page objects are then rasterized to be output to a printer (column 1, line 24-column 3, line 11 of Barry). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Rivette with the method of Barry because it would have simplified the use of an output device to render a multi-paged document.

**Regarding dependent claims 2 and 3,** Rivette discloses a method in which the source document is transformed into a result document in a second language, wherein it includes formatting properties (including page divisions) provided by the layout data structure, which is a separate document (column 3, line 30-column 5, line 12 of Rivette). Rivette does not disclose that multiple page objects are generated from the result document. However, Barry discloses a method in which a document is split into multiple page objects that contain the source content and formatting for one page (column 1, line 24- column 3, line 11 of Barry). It would have been obvious to one of

ordinary skill in the art at the time the invention was made to have combined the method of Rivette with the method of Barry because it would have simplified the use of an output device to render a multi-paged document.

**Regarding dependent claims 5 and 7,** Rivette does not disclose page objects which are in a third presentation language which is a page description language. However, Barry discloses a method in which a document is split into multiple page objects that contain the source content and formatting for one page in a different page description language (image bit-map) (column 1, line 24- column 3, line 11 of Barry). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Rivette with the method of Barry because it would have simplified the use of an output device to render a multi-paged document.

**Regarding dependent claims 8 and 10,** Rivette discloses a method in which the result document contains multiple page instances, which are all in the same language as the result document, which is a device independent language (column 3, line 30-column 5, line 12 of Rivette).

**Regarding dependent claim 11,** Rivette discloses a method in which source content is in a page description language (column 3, line 30-column 5, line 12 of Rivette).

**Regarding dependent claim 12,** Rivette discloses a method in which the result document contains multiple page instances, which are all in the same language as the result document, which is a device independent language (column 3, line 30-column 5, line 12 of Rivette).

**Regarding dependent claim 14**, Rivette discloses a method in which the source document does not indicate page divisions (column 3, line 30-column 5, line 12 of Rivette).

**Regarding independent claim 15 and dependent claims 16-17, 19, 21-22, and 24-28**, the claims incorporate substantially similar subject matter as claims 1-3, 5, 7-8, and 10-14. Thus, the claims are rejected along the same rationale as claims 1-3, 5, 7-8, and 10-14.

**Regarding independent claim 29 and dependent claims 30-31, 33, 35-36, and 38-42**, the claims incorporate substantially similar subject matter as claims 1-3, 5, 7-8, and 10-14. Thus, the claims are rejected along the same rationale as claims 1-3, 5, 7-8, and 10-14.

9. Claims 4, 6, 9, 18, 20, 23, 32, 34, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. (hereinafter Rivette, US Patent Number 6,018,749, issued on January 25, 2000) in view of Barry et al. (hereinafter Barry, US Patent Number 6,606,165, filed on January 8, 1999) as applied to claims 2, 15-16, and 31 above, and further in view of Sall (as found in the IDS - FOP: Formatting Object to PDF Translator (James Tauber, published in 1999)).

**Regarding dependent claims 4 and 9**, Rivette does not disclose that the source document language is XML and the result document language is XSL-FO based on a layout of an XSL stylesheet. However, Sall discloses a method in which an XML is converted to XSL-FO based on an XSL stylesheet (pages 1-2 of Sall). It would have



been obvious to one of ordinary skill in the art at the time the invention was made to have combined Rivette with methods taught by Sall because this method was noted to be a potential replacement for typical desktop published due to formatting advantages.

**Regarding dependent claim 6,** Rivette does not disclose that the source document language is XML and the result document language is XSL-FO based on a layout of an XSL stylesheet. However, Sall discloses a method in which an XML is converted to XSL-FO based on an XSL stylesheet, then based on XSL-FO convert the document to a PDF (pages 1-2 of Sall). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Rivette with methods taught by Sall because this method was noted to be a potential replacement for typical desktop published due to formatting advantages. In addition to this it was well known at the time the invention was made that both the format of PDF and MO:DCA are imaging formats that were readily and easily converted back and forth between each other.

**Regarding dependent claims 18, 20, and 23,** the claims incorporate substantially similar subject matter as claims 4, 6, and 9. Thus, the claims are rejected along the same rationale as claims 4, 6, and 9.

**Regarding dependent claims 32, 34, and 37,** the claims incorporate substantially similar subject matter as claims 4, 6, and 9. Thus, the claims are rejected along the same rationale as claims 4, 6, and 9.

### ***Conclusion***

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10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent Number 4,709,348

US Patent Number 6,084,688

US Patent Number 6,480,866

extensibility xml authority, 1999, Structured Methods

Grosso et al., XML Fragment Interchange, February 2001

Formatting Objects, 2000

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (703)305-5764. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703)308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDC  
May 13, 2004

  
**STEPHEN S. HONG**  
**PRIMARY EXAMINER**